

Remarks

The Office action identifies three groups of claims that are allegedly directed to distinct inventions: Group I (claims 1-9, which are said to be directed to "a method of manufacturing corrugated board, classified in class 156, subclass 205), Group II (claims 10-19, which are said to be directed to "an apparatus for manufacturing a corrugated product, classified in class 156, subclass 462), and Group III (claim 20, which is said to be drawn to "a corrugated article, classified in class 428, subclass 182). In view of the foregoing amendments and the following remarks presented in Sections I and II, below, reconsideration of the withdrawn claims and consideration of the new claims are respectfully requested.

Claim 12 has been rejected under 35 U.S.C. § 112, second paragraph. Claims 10-12 and 15-17 have been rejected under 35 U.S.C. § 102(b) as being anticipated by any one of Swift, U.S. Patent No. 1,199,508 (Swift), and Wallick, U.S. Patent No. 5,292,391 (Wallick '391) or Wallick, U.S. Patent No. 5,332,458 (Wallick '458). In view of the remarks presented in Section II, below, allowance of the rejected claims is respectfully requested.

I. RESPONSE TO THE RESTRICTION REQUIREMENT

A. Restriction Between Groups I and II is Moot in View of the Amendment Made to Claim 1 of Group I

In requiring a restriction between the claims of Groups I and II, the Examiner states that the process claimed in Group I can be practiced by another materially different apparatus than that recited in Group II. In particular, the Examiner states that the process of Group I can be practiced without a corrugating device as required by the

apparatus claims of Group II, because the process claims of Group I only require a supply of corrugated material.

The applicant has amended claim 1 to additionally recite "corrugating the first web of medium to include a plurality flutes on each side thereof" Accordingly, claim 1 now recites a step of corrugating the first web of medium, rather than only requiring a supply of corrugated material. Therefore, the claims of Group I and II are no longer materially different under the distinctness criteria articulated in MPEP § 806.05(e), and the restriction between Groups I and II is now moot and should be withdrawn.

B. Restriction Between Species Should be Withdrawn in view of the Restriction Between Groups I and II being Moot and Arguments Presented Herein in Support of the Allowability of the Generic Claims.

The Office action identifies nine species that are allegedly directed to distinct inventions:

Species I, where the water supply device is an anilox system (Group I claim 4 and Group II claims 12, 13, 14, 18, 19).

Species II, where the water supply device is a sprayer (Group I claim 4 and Group II claim 12).

Species III, where the water supply device is a plurality of rollers (Group I claim 4 and Group II claim 12).

Species IV, where the water supply device is a rod coater (Group 1 claim 4 and Group II claim 12).

Species V, where the water supply device is a belt system (Group 1 claim 4 and Group II claim 12).

Species A, where the adhesive is a starch composition (Group I, claim 5).

Species B, where the adhesive is a water based adhesive composition (Group I, claim 5).

Species X, where the anilox system has a doctor blade (Group II, claim 13).

Species Y, where the anilox system has a second roll (Group II, claims 14, 18, 19).

Claim 4 as filed recites Species I-V. Claim 4 has been cancelled. Instead, claims 24-28 have been added, each of which recites one of the Species I-V.

Additionally, claims 24-28 directly depend from generic claim 1.

Claim 12 as filed recites Species I-V. Claim 12 has been amended to only recite Species I. Instead, claims 34-38 have been added, each of which recites one of the Species II-V. Additionally, claims 34-38 directly depend from generic claim 10.

Claim 5 as filed recites Species A and B. Claim 5 has been amended to only recite Species A. Instead, claim 21 has been added, which only recites Species B. Claims 5 and 21 directly depend from generic claim 1.

Claim 13 recites Species X and indirectly depends from claim 10 through intervening claim 12. Similarly, claim 14 recites Species Y and indirectly depends from claim 10 through intervening claim 12.

MPEP § 806.04(d) states that "the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim." Additionally, the same MPEP section states that "[o]nce a claim that is determined to be generic is allowed, all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim,"

Applicant has presented arguments in Section II, below, in support of allowability of generic claims 1 and 10. Accordingly, in view of generic claims 1 and

10 being in allowable form, the restriction of Species I-V, A and B, and X and Y should be withdrawn.

C. The Standard for Requiring Restriction Has Also Not Been Met Because Search and Examination of the Entire Application Can be Made Without Serious Burden on the Patent Office

The applicant respectfully disagrees with the restriction requirement. A restriction requirement is only proper when search and examination of the entire application would be a serious burden on the Patent Office. For example, MPEP §803 reads “[i]f the search and examination of an entire application can be made without serious burden, the Patent Office must examine it on the merits, even though it includes claims to distinct or two independent inventions.” The Patent Office has not asserted that the search and examination of the entire application would pose a serious burden. In fact, Group I and II of the claims share the same patent classification, namely, class 156.

The time, effort, and resources of both the applicant and the Patent Office would be wasted if the method, apparatus and product claims were prosecuted in separate applications. The search and examination of the three groups of claims together would be much more efficient than requiring the Patent Office and the applicant to do so separately in multiple applications. The same reasoning applies to the examination of the asserted species. Accordingly, the applicant respectfully requests that the restriction requirement be withdrawn.

D. The Effects of the Patent Office's Position are Various Admissions Concerning Patentability

The effect of the position in the Office action is that the Patent Office admits that the claims of each one of the Groups I-III is patentable over a disclosure of the combination of another one of the Groups I-III, and vice versa. M.P.E.P. § 802.01

states that the distinctness required for restriction means that the subjects, including a "process and apparatus for its practice... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER" (emphasis with capital letters in original). (*See also* M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the disclosure of the method according to the Group I claims, the claimed apparatus of the Group II claims, and the disclosure of the product in Group III claim are patentable over each other. *See, e.g.*, M.P.E.P. § 802.01. Each of independent claims 1, 10, 18 and 20 includes similar elements as the other independent claims, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicant during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the Patent Office is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

E. Provisional Election with Regard to the Restriction Requirement

The applicant hereby affirms the provisional election of Group II, Species II, that was made with traverse during a telephone conversation between Tom Miller and Examiner Piazza on June 26, 2003.

Since the applicant has cancelled and amended some of the claims and added new claims, the provisional election with traverse is now directed to the following claims that fall under Group II, Species II: Claims 10, 11, 15-17, and 35.

In doing so, the applicant does not intend to abandon the scope of the non-elected claims as originally filed those amended herein, and those newly added herein, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

II. RESPONSE TO REJECTION OF CLAIMS

A. Rejection of Claim 12 under 35 U.S.C. § 112, Second Paragraph

Claim 12 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 12 has been amended to only recite that "the wetting device comprises an anilox system." Instead, claims 35-38 have been added, which recite that the wetting device comprises a sprayer, a plurality of rollers, a rod coater, and a belt system, respectively. Accordingly, claim 12 now only recites a nonelected species. Therefore, rejection of claim 12 should be withdrawn.

B. Rejection of Claims 10-12 and 15-17 under 35 U.S.C. § 102(b)

Claims 10-12 and 15-17 have been rejected under 35 U.S.C. § 102(b) as being anticipated by any one of Swift and Wallick '391 or Wallick '458 (referred to below only as Wallick). Claim 10 has been amended to recite, in part, an apparatus for manufacturing a corrugated product comprising a wetting device and an adhesive supply device. In contrast, neither Swift nor Wallick discloses a wetting device. Swift discloses an adhesive material spraying device 6 for spraying an adhesive material 5 on the corrugated web 4. Swift further discloses another adhesive applicator 27 for

applying the adhesive material 5 to the corrugated web 4. Wallick discloses a glue applicator 42 and a resin applicator 48, both of which apply an adhesive material to the fluted medium 25. Accordingly, neither Swift nor Wallick discloses a wetting device adapted to apply a wetting agent to a plurality of crests on the first side of the first web. Both Swift and Wallick simply include a first adhesive application device 6 and a second adhesive application device. Therefore, for at least this reason, claim 10 is patentable over any one of Swift and Wallick.

Furthermore, claim 10 also recites that the wetting device is adapted to apply a wetting agent to only a plurality of crests on the first side of the first web, and the adhesive supply device is adapted to apply an adhesive composition to only the plurality of crests on the first side of the first web. In contrast, both the adhesive spray device 6 of Swift and the adhesive spray device 48 of Wallick apply adhesive material to the entire surface of their respective corrugated web. Referring to FIGS. II-VIII of Swift, the adhesive material 5 is shown to be applied to the entire surface of the web 4, and not just to the crests of the web 4. Referring to FIG. 2a of Wallick, sprayer 78 applies resin material to the entire surface of the fluted medium 25. Therefore, for at least this reason, claim 10 is patentable over any one of Swift and Wallick.

Based on the foregoing, claim 10 is in condition for allowance. Claims 11-17 and 35-38 depend from claim 10 either directly or through intervening claims, and therefore, these claims are also in condition for allowance.

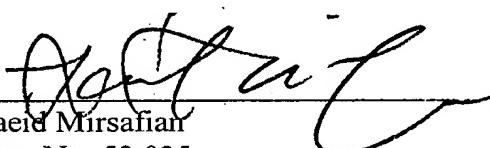
Claim 1 has been amended. Claim 7 has also been amended and placed in independent form. As discussed in the above section I.A., restriction between the claims of Group I, which includes claims 1 and 7, and the claims of Group II, which

includes claim 10, is now moot. Therefore, reconsideration of the claims 1-9, and consideration of new claims 21-34 are respectfully requested.

Additionally, both claims 1 and 7 recite the steps of applying a wetting agent to a plurality of crests on the first side of the first web, and applying an adhesive composition to the plurality of crests on the first side of the first web. Accordingly, claims 1 and 7 are patentable over Swift and Wallick for the same reasons as those set forth above with respect to the patentability of claim 10 in view of Swift and Wallick. Therefore, claims 1-9 and 21-34 are now in condition for allowance.

The examiner is invited to contact the undersigned at the telephone number listed below in order to discuss any remaining issues or matters of form that will place this case in condition for allowance.

Respectfully submitted,


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